

Appl. No. : 09/557,234
Filed : April 24, 2000

REMARKS

In response to the Office Action mailed March 15, 2004, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the above amendments and the following remarks.

The Cited Prior Art Does Not Teach or Suggest All of the Limitations Recited in the Claims

The Examiner rejected Claims 19-24, 33 and 35-40 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Des. 425,603 to Guo in view of Kimbrew-Walter Roses "Jet-All" sprayer. The Examiner rejected Claims 25-28 and 34 under 35 U.S.C. § 103(a) as unpatentable over the Guo/Jet-all combination and in further view of U.S. Patent No. 3,737,105 to Arnold.

Applicant respectfully traverses the rejection. Applicant notes that the recited combinations do not recite all of the structure provided in the claimed methods, and that the Examiner has pointed to no facts that teach the recited method steps. Further, as will be discussed below, the Examiner has applied an incorrect standard of patentability for method claims, and the Examiner has not properly supported use of the legal term "inherent". The Examiner's rejections lack the specific factual support required to satisfy the Examiner's prima facie burden.

Examiner Has Not Applied Correct Standard of Patentability

In the Office Action, the Examiner asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to apply the apparatus taught by Guo in a method of insect removal taught by 'Jet-all'." Thus, Applicant understands that the Examiner's rejection is based only on the structure of Guo used according to the method taught by Jet-All.

The Examiner contends that the Guo/Jet-all combination "contains all of the structural limitations of Applicant's claim language", and then states:

The intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Office Action, Page 3.

This is an incorrect statement of patent law, and it directly contradicts the MPEP. The MPEP clearly states that "New and unobvious uses of old structures and compositions may be patentable." M.P.E.P. § 2112.02 (emphasis in original).

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The Examiner included this statement in the Office Action mailed May 29, 2003, and Applicant presented a pointed discussion showing that it is an incorrect statement of law. However, the Examiner has not acknowledged Applicant's discussion and has, again, made this incorrect statement. This is an important issue that should be addressed, because it indicates that the Examiner is making the claim rejection based on an inaccurate application of the law.

Examiner Has Not Properly Supported Assertions of Inherency

The Examiner refers several times to "inherent" features or teaching of the cited combinations. However, the Examiner has not presented any evidence to establish inherency. As stated in the M.P.E.P.:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized* by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. §2112 (citing *In re Robertson*, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999))(emphasis added).

Thus, for every contention of "inherency", the Examiner must establish that the method limitation 1) is necessarily present in the Guo/Jet-all combination, and 2) would be recognized. The Examiner has not presented facts to support her several assertions of inherency, and thus has not satisfied her burden as required by the MPEP.

Structure of Guo/Jet-all Combination Does Not Teach Structure Provided in Claims

As discussed above, the Examiner bases the rejection on a device having the structure of Guo used according to the method of Jet-all. Office Action, page 3.

Following are discussions of some of the Examiner's contentions. The following discussions show that the Examiner has not properly supported the claim rejections, particularly the rejections based on "inherency."

Claim 19

The Guo/Jet-all combination does not teach or suggest all of the structure provided in Claim 19, and does not teach or suggest the other method steps of Claim 19.

For example, Claim 19 recites, *inter alia*, providing an apparatus with a nozzle portion "being adapted to direct a generally continuous water flow in a direction outwardly from the axis around substantially the entire circumference of the nozzle axis". Guo includes no specific

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teaching about water flow, but Figures 5-6 indicate that the Guo nozzle emits several individual, discontinuous streams of water in a direction generally along Guo's longitudinal axis.

The Examiner asserts that the Guo/Jet-all combination "inherently teaches rotating the apparatus at least about 90 degrees so that the longitudinal axis of the nozzle is moved to a second elevation but remains generally horizontally disposed during rotation and advancing and retracting the nozzle generally horizontally at the second elevation to efficiently and effectively treat all size plants." As discussed above, the Examiner must present facts sufficient to establish that each of these assertions 1) would necessarily be present in the Guo/Jet-all combination, and 2) would be recognized by a user of the Guo/Jet-all combination. The Examiner has not presented facts to support these assertions of inherency, and thus has not satisfied her burden under the law and MPEP.

As such, Applicant respectfully requests that the Examiner withdraw her rejection of Claim 19, and Claims 20-28 and 33-35, which depend therefrom.

Claim 21

The Examiner asserts that "Guo as modified teaches the nozzle being adapted to direct flow of water in a substantially vertical plane (Guo Fig. 1)." Figure 1 of Guo simply shows the Guo device, and does not support this contention. Figures 5 and 6 of Guo indicate that Guo emits several discontinuous streams of water. There is no indication or teaching that the water is ever in a vertical plane.

Claim 22

The Examiner contends "It would have been obvious to one of ordinary skill in the art to modify the teaching of Guo with the spray direction of 'Jet-All' *for an increase in coverage area.*" Office Action, page 4 (emphasis added). Applicant respectfully asserts that the Examiner's combination is improper. Obviousness requires that there be a teaching in the references to support a combination. There is no such teaching here. Nothing in Guo indicates that an increase in coverage area would be desired. In fact, the nozzle pattern shown in Figures 5-6 of Guo indicates that a well-regulated, confined water flow directed away from the user is desired. Adding the spray direction of "Jet-all" would disrupt the design of Guo. There is no teaching in these references to support this combination.

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Claims 23 and 33

The Examiner asserts that the Guo/Jet-all combination "inherently teaches the step of adjusting the elevation of the body portion by rotating the handle about a proximal end of the handle." Office Action, page 4. As discussed above, the Examiner must present facts sufficient to establish that this assertion 1) would necessarily be present in the Guo/Jet-all combination, and 2) would be recognized by a user of the Guo/Jet-all combination. The Examiner has not presented facts to support this assertion of inherency, and thus has not satisfied her burden under the law and MPEP. Further, the Guo/Jet-all combination does not address or teach any benefit to "rotating the handle about an axis of rotation generally parallel to the longitudinal axis of the nozzle", as recited in Claim 33.

Claim 24

The Examiner asserts that the Guo/Jet-all combination "inherently discloses advancing and retracting the apparatus into and out of the plant at a plurality of locations, so that water directed by the nozzle simultaneously impacts the top side of a first plant leaf along at least a portion of its length and the underside of a second plant leaf along at least a portion of its length." Office Action, page 4. Jet-all teaches only spraying the undersides of plant leaves. Guo doesn't teach anything about spraying. Thus, this limitation is not taught or suggested by the cited art. As discussed above, the Examiner must present facts sufficient to establish that this assertion 1) would necessarily be present in the Guo/Jet-all combination, and 2) would be recognized by a user of the Guo/Jet-all combination. The Examiner has not presented facts to support this assertion of inherency, and thus has not satisfied her burden under the law and MPEP.

Claim 35

The Examiner contends that Guo teaches the body and nozzle portions being substantially straight and having substantially the same longitudinal axis (Examiner refers to Guo, Fig. 1). However, in rejecting Claims 23 and 33, the Examiner contends that Figure 1 of Guo "includes a bend point." These are inconsistent statements. In fact, Guo does NOT teach the claimed limitation.

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Combination of Cited References Do Not Inherently Teach or Make Obvious Claimed Invention

Applicant notes that the Examiner appears to have summarized her position in the paragraph immediately prior to the Conclusion of the Office Action:

Examiner maintains that it would be an inherent/obvious movement to perform the steps of advancing, retracting, and rotating the device to reach all locations of a plant depending on the plant size and configuration. Office Action, p. 7.

As discussed above, an assertion of "inherency" requires specific factual support. An assertion of "obviousness" also requires teachings in the references to support a combination. Further, an assertion of "obviousness" still requires that the references teach all claim limitations.

The Examiner has not backed up the inherency/obviousness rejections with appropriate factual evidentiary support. As such, no prima facie case of obviousness or inherency has been made.

Since the cited art does not teach or suggest all of the limitations of the claims, Applicant respectfully requests that the Examiner withdraw the claim rejections.

Secondary Considerations Further Support Patentability

The Examiner discounted the declarations submitted by Applicant in support of secondary considerations supporting patentability. Applicant respectfully disagrees with the Examiner regarding such declarations, and contends that they show that the Applicant's invention is commercially successful, and satisfies a long-felt, previously unsolved need. Nevertheless, Applicant reserves the right to supplement the Declaration evidence.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections and objections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

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The undersigned has made a good faith effort to respond to the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

7/15/04

By: _____

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